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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,321	01/06/2005	Serge Creutz	SN132 PCT 1	9052

137 -7590 02/22/2007
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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/22/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/22/2007.

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patents.admin@dowcorning.com

Office Action Summary

Application No.

10/521,321

Applicant(s)

CREUTZ ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/8/07 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/6/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' election in response to the restriction requirement filed on February 8, 2007 was received. Group I is elected with traverse. Group II is drawn to a non-elected invention.
2. In view of Applicants' argument, Examiner has reconsidered any restriction requirement regarding the instant application and has decided to give an action on the merits for all claims.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claim 16 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 17 of copending Application No. 10/521,416. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claim 17 of the copending Application is directed to a foam control composition comprising a polydioragnosiloxane, a hydrophobic filler having a specific particle size, a non-polar polyol ester, which obviously read on the instant claim of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In Claims 1 (page 3, line 14) and 3 (page 3, line 21), “substantially fully esterified” causes confusion because if there are un-esterified hydroxyl groups in the polyol, the resulting polyol ester will not be non-polar. Furthermore, it is not clear as to what extent of the polyol being esterified in order to be called “substantially” fully esterified. Especially, note that if the polyol is not fully esterified, it is not clear as to the difference between these substantially fully esterified polyol esters and the polyol ester having unesterified -OH group recited in Claim 7.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashiuchi (US 5 900 456).

Hashiuchi discloses a composition comprising an **organopolysiloxane** represented by formula (1) and waxes such as **paraffin wax, microcrystalline**

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wax. (col. 2, lines 4-19, col. 3, lines 19-45) The organopolysiloxane is further exemplified in examples. Since the paraffin reads on that of Applicants', both should possess the same properties, such as melting point and polydiorganosiloxane fluid miscibility, etc. Note that "foam control" in the preamble of the instant claim is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02.

9. Claims 1, 3 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickinson (GB 1 523 957).

Dickinson discloses a **granular** or aqueous emulsion-based foam control composition comprising a **polydiorganosiloxane** containing radicals such as ethyl, propyl, octyl, tetradecyl, phenyl, benzyl, 2-phenylpropyl, etc., waxes such as polyethylene wax (a **paraffin wax**), **microcrystalline wax**, etc. having specific melting points, a **silica** or **aluminum oxide** and an emulsifying agent such as **polyoxyethylene distearate**. (page 1, line 21 to page 2, line 28 and Examples) An **MQ resin** with a specific M to Q unit-ratio can be present. (page 2, lines 15-17 and Examples) Since the silica is compounded in the presence of the ingredients such as the polysiloxanes and/or the MQ resin, it is inherently surface-modified in-situ. The amount of the wax and emulsifying agent (i.e., additive composition) is

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described in page 2, lines 52-65. The granulated foam control agent is prepared by utilizing the foam control composition supported on a particulate carrier such as sodium tripolyphosphate, etc. in non-aqueous liquid form. (page 2, lines 29-43 and Examples)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 6 610 752) in view of L'Hostis (EP 1 075 863).

The following column and line numbers of L'Hostis is based on its U.S. equivalent, US 6 521 587.

For Claims 1-15 and 17-20, Schmid discloses a granular foam control composition comprising a **polydiorganosiloxane** containing methyl, ethyl, propyl, butyl and phenyl groups, a **microfine silanized silica**, a polyol ester such as the

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esters of glycerol and palmitic acid (typically containing a mixture of **glycerol mono, di-, and tripalmitate**), etc., a **bisamide**, a **fatty acid**, a **microcrystalline paraffin wax**. (col. 2, line 34 to col. 5, line 56 and Examples) The granular foam control composition can be prepared according the method described in col. 3, line 19 to col. 4, line 13, col. 5, line 57 to col. 7, line 67 and Examples. Schmid is silent on a) the polydiorganosiloxane where the substituents have the claimed mean number of carbon atoms, the claimed long chain alkyl group or the claimed X-Ph moiety; and b) a silicone resin. L'Hostis teaches the use of in a foam control composition a polyorganosiloxane and a silicone resin that read on the claimed ones. The motivation of using the specific polyorganosiloxane and the silicone resin is to afford a granular foam control composition with **enhanced foam control efficiency**. (col. 2, lines 46-51, col. 2, line 64 to col. 3, line 46, col. 4, line 64 to col. 5, line 28 and col. 7, line 65 to col. 8, line 35) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' polyorganosiloxane and silicone resin in Schmid's composition with expected success. Especially, L'Hostis is in the same field as that of Schmid's endeavor.

For Claim 16, Schmid is silent on the **microfine** silanized silica having the claimed average particle size. However, L'Hostis teaches that it is well known to

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use hydrophobic fillers such as silica with particle size of 0.5 to 50 **microns** for foam control agents. The silica is well known and is **commercially available**. (col. 6, line 60 to col. 7, line 28) As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' silica filler in Schmid's composition because Schmid's silica is **microfine** and the commercial availability of L'Hostis' silica. Especially, L'Hostis is in the same field as that of Schmid's endeavor, and Applicants do not show the **criticality** of the particle size.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

February 16, 2007



Kuo-Liang Peng
Primary Examiner
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